Intel Corporation
Docket # P17517

Serial No. 10/723,347

Remarks

The Official Action requires Applicant to elect between for identified species for

prosecution on the merits. Although a provisional election will be made as indicated

below, this restriction requirement is respectfully traversed.

As discussed in MPEP §803 in order for a requirement for restriction between

patentably distinct inventions to be proper:

> (A) The inventions must be independent (see MPEP § 802.01, §
> 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 -§
> 806.05(i)); and
> (B) There must be a serious burden on the examiner
> if restriction is required (see MPEP § 803.02, § 806.04(a).-§
> 806.04(i), § 808.01(a), and § 808.02).

Further, MPEP §803 states Examiners must provide reasons and/or examples to

support conclusions.

The Official Action appears to be devoid of reasons for requiring the present

restriction. Furthermore, the Official Action appears to provide no indications that a

serious burden would be placed on the Examiner if such a restriction was not required.

Accordingly, the Official Action has not satisfied the criteria required to support a

restriction requirement.

Without information regarding the reasons for restriction and the reasons a

serious burden would be placed on the Examiner, the Applicant is placed in a very

difficult position in trying to ascertain the correctness of the restriction. In other words,

the Applicant is unable to assess the reasoning for the restriction since such reasoning

does not appear to be presented.

2

Intel Corporation
Docket # P17517

Serial No. 10/723,347

In the instant case, the Official Action appears to merely provide conclusions without the required supported reasoning and/or examples. In particular, the Official Action appears to merely identifying species by classifying each independent claim and it's dependents as a separate species without identifying why the Examiner believes such a classification results in independent or distinct species. As stated in MPEP §806.04:

> Claims are definitions of inventions. Claims are never species.
> Claims may be restricted to a single disclosed embodiment (i.e., a single species, and thus be designated a specific species claim), or a claim may include two or more of the disclosed embodiments within the breadth and scope of definition (and thus be designated a generic or genus claim)

Despite what appears to be an incomplete record from which to work, the Applicant would like to point out a few things to aid the Examiner in reassess the present restriction requirement. First, MPEP §806.03 states:

> Where the claims of an application define the same essential characteristics of a single disclosed embodiment of an invention, *restriction therebetween should never be required.* This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition. (emphasis added).

In the present application, FIG. 1 depicts an embodiment of a computing device having an audio controller and FIG. 2 depicts the audio controller of FIG. 1 in more detail. All of the originally filed claims 1-28 are readable upon the embodiment depicted in FIGS. 1-2. The Official Action appears to provide no reasons why the present claims which are all readable upon the embodiment depicted in FIGS. 1-2 should be restricted despite MPEP §806.03 indicated that such a restriction should never be required.

3

Intel Corporation
Docket # P17517

Serial No. 10/723,347

Furthermore, as discussed in MPEP §806.04(f), claims that are restricted to different species must be mutually exclusive. MPEP §806.04(f) states "the general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first."

The species identified in species 1-4 are clearly not mutually exclusive. For example, all independent claims (and consequently, all claims) recite a feature that could be said to relate to transferring data between a codec and a buffer. Accordingly, it cannot be said that "one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first". Accordingly, the test under MPEP §806.04(f) is not satisfied and the species 1-4 cannot properly be restricted.

In so far as the Examiner maintains the restriction requirement (which, as discussed above, is improper), Applicant provisionally elects species 3 which includes claims 13-18, 25-28 as identified by the Examiner. However, the Applicant believes species 3 should further include claims 1-12 and claim 19 since the concept of transferring data between a codec and a buffer is generic to all of these claims. Applicant further points out that while the Examiner identified species 4 as "having two direct memory controllers" and placed claim 19 in species 4, claim 19 in fact only claims a single direct memory controller.

4

Intel Corporation
Docket # P17517

Serial No. 10/723,347

Conclusion

The foregoing is submitted as a full and complete response to the Official Action.

Applicant submits that all remaining claims are in condition for allowance.

Reconsideration is requested, and allowance of all remaining claims is earnestly

solicited.

Should it be determined that an additional fee is due under 37 CFR §§1.16 or

1.17, or any excess fee has been received, please charge that fee or credit the amount

of overcharge to deposit account #50-0221. If the Examiner believes that there are any

informalities which can be corrected by an Examiner's amendment, a telephone call to

the undersigned at (480) 715-5388 is respectfully solicited.

Respectfully submitted,
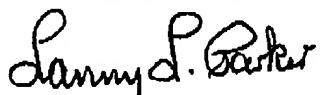
Lanny L. Parker
Patent Agent for Intel Corporation
Reg. No. 44,281

c/o Blakely, Sokoloff, Taylor & Zafman, LLP
12400 Wilshire Blvd.
Seventh Floor
Los Angeles, CA 90025-1030
(408) 720-8300

5